



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,849	01/12/2004	Walter M. Bain	1311.DDN.CN	8439
27472	7590	03/06/2006	EXAMINER	
RANDALL B. BATEMAN BATEMAN IP LAW GROUP 8 EAST BROADWAY, SUITE 550 PO BOX 1319 SALT LAKE CITY, UT 84110			SHAPIRO, JEFFERY A	
			ART UNIT	PAPER NUMBER
			3653	
DATE MAILED: 03/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/755,849	BAIN, WALTER M.	
	Examiner	Art Unit	
	Jeffrey A. Shapiro	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Transitional After Final Practice

1. Regarding the request for withdrawal of the finality of the last action, dated 12/30/05, Applicant is correct in that the Examiner incorrectly applied the combination of Williams, Schlamp and Liff to Claims 81-92 and 94. In response, this rejection has been withdrawn and replaced with the prior rejection of Williams and Schlamp. Since this rejection could have been made final if made in the prior action, this action is also made final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by the phrase "and storing electronically via control portion information regarding the filled prescriptions."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3653

5. Claims 60-80, 93 and 95-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US 5,597,995) in view of Schlamp (US 5,385,265) and further in view of Liff et al (US 5,713,485).

Williams discloses a semi-automated pharmacy for filling prescriptions for customers with a will call area (380) (see col. 10, lines 48-53) in which finished prescriptions are kept for customers. Williams further discloses a computer (104) for inputting customer data and prescription data.

Williams does not expressly disclose, but Schlamp discloses a dispenser placed in a wall, for holding items such as filled prescriptions, for customers with access to a particular bin by the customers on one side of the wall and access to a particular bin by the pharmacist to load a customer's prescription on the other side of the wall.

Both Williams and Schlamp are considered analogous art because they both concern article handling, and in particular, Williams concerns filling and storing prescriptions for customers while Schlamp discloses holding finished items for customers. See Schlamp, figures 1 and 2 and col. 1, line 55-col. 2 line 46 and col. 6, lines 29-60.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added Schlamp's "will call" device to Williams pharmacy, said device allowing the loading of finished prescriptions into a merchant side of the system and allowing customer pickup of the finished prescription on the other side of the "will call" device, the "will call" device located in a wall between the secure pharmacy prescription filling area and an unsecure customer pickup area on the other side of a wall.

As suggested by Schlamp, one ordinarily skilled would have been motivated to use Schlamp's device in Williams' pharmacy to reduce storage area, reduce the distance required by the pharmacist to reach system, to secure the filled prescriptions while allowing access by customers to their prescriptions after hours, and to provide for cooling/refrigeration of the unit. See Schlamp, col. 2, lines 4-44.

Williams does not expressly disclose, but Liff discloses using sensors (36) to determine the location of packages of pharmaceuticals in a particular bin. See Liff at col. 2, lines 46-49 and col. 5, lines 7-14.

Regarding claims 68 and 93, Williams does not expressly disclose, but Liff discloses billing a third party insurance provider for the prescription. See Liff at col. 4, lines 35, 36 and col. 9, lines 12-19.

Both Liff and Williams are considered analogous art because they both concern pharmaceutical delivery systems.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have charged a third-party healthcare provider in Williams' pharmacy, as taught by Liff.

The suggestion/motivation would have been to allow customers to pay for prescriptions through standard well-known third-party insurance providers.

It also would have been obvious to use sensors to detect prescriptions in each of William's bins, as taught by Liff.

The suggestion/motivation would have been to detect jammed bins as well as to monitor inventory. See Liff at col. 4, lines 35, 36 and col. 9, lines 12-19.

Art Unit: 3653

6. Claims 81-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US 5,597,995) in view of Schlamp (US 5,385,265).

Williams discloses a semi-automated pharmacy for filling prescriptions for customers with a will call area (380) (see col. 10, lines 48-53) in which finished prescriptions are kept for customers. Williams further discloses a computer (104) for inputting customer data and prescription data.

Williams does not expressly disclose, but Schlamp discloses a dispenser placed in a wall, for holding items such as filled prescriptions, for customers with access to a particular bin by the customers on one side of the wall and access to a particular bin by the pharmacist to load a customer's prescription on the other side of the wall.

Both Williams and Schlamp are considered analogous art because they both concern article handling, and in particular, Williams concerns filling and storing prescriptions for customers while Schlamp discloses holding finished items for customers. See Schlamp, figures 1 and 2 and col. 1, line 55-col. 2 line 46 and col. 6, lines 29-60.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added Schlamp's "will call" device to Williams pharmacy, said device allowing the loading of finished prescriptions into a merchant side of the system and allowing customer pickup of the finished prescription on the other side of the "will call" device, the "will call" device located in a wall between the secure pharmacy prescription filling area and an unsecure customer pickup area on the other side of a wall.

As suggested by Schlamp, one ordinarily skilled would have been motivated to use Schlamp's device in Williams' pharmacy to reduce storage area, reduce the distance required by the pharmacist to reach system, to secure the filled prescriptions while allowing access by customers to their prescriptions after hours, and to provide for cooling/refrigeration of the unit. See Schlamp, col. 2, lines 4-44.

Response to Arguments

7. Applicant's arguments filed 2/13/06 have been fully considered but they are not persuasive. Applicant asserts that Schlamp and Williams are not combinable and could only be arrived at through hindsight. However, Schlamp specifically teaches holding a merchant's finished items for customers in Schlamp's bins. Williams teaches a pharmacy production area in which pharmacists fill and produce prescriptions for customers and place them in a "will call" area. It would have been obvious, based on Schlamp's teaching as cited above at col. 2, lines 4-44, which explicitly states that Schlamp's vending device is installed such that one bin door is located facing the merchant and the other bin door on the opposite side faces the customer, much like a cooled dairy freezer in a supermarket, in which the merchant loads the milk from the inside, and the customer opens the door from the opposite side to remove the milk. Therefore, there is suggestion for one ordinarily skilled in the art to use Schlamp's vending apparatus in place of the William's will call area.

Regarding Claim 81, note that Williams discloses using a label with a barcode on drug vials and verifies such information with a checking station. See Williams, abstract.

Art Unit: 3653

Williams also discloses the “requiring of multiple pieces of information associated with a patient and verifying at least one of patient information and prescription information with the person prior to filling the prescription”, as recently amending in Claim 81. See, for example, Williams, figure 2. Schlamp discloses a vending machine with access from a merchant side and access by a customer on an opposing side. There are several reasons, described above, for using such a dispenser with access from both sides. One is to reduce the amount of time a merchant has to spend restocking the vending machine. The other is to keep one side of the machine, the restocking side, in a secure environment. This is suggested again, by Schlamp, for example, at col. 2, lines 14-35. Use specifically with a prescription is not necessary for providing motivation to use Schlamp in combination with Williams since these citations provide such motivation.

Further, concerning other claims rejected in using Liff, this piece of prior art discloses using sensors at each bin to detect and monitor inventory. Liff also discloses an information network of various dispensers with different configurations. It is intended that Liff's system be used with various dispensers, such as Schlamp's. Applicant's claims do not provide limitations that preclude use of Schlamp, Williams or Liff. Therefore, it would have been obvious to combine Schlamp, Williams and Liff to obtain Applicant's apparatus and method as claimed.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosenblum '941 is cited as a custom pharmaceutical vending apparatus.

Art Unit: 3653

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571)272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

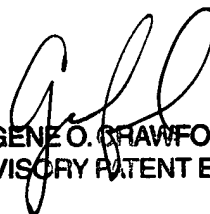
Art Unit: 3653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Shapiro
Examiner
Art Unit 3653

February 28, 2006



GENE O. CRAWFORD
SUPERVISORY PATENT EXAMINER